

Serial No. 10/693,035

Remarks

The various parts of the Office Action (and other matters, if any) are discussed below under appropriate headings.

Claim Rejections - 35 USC § 112

Claims 1-8 were rejected for failing to comply with the written description requirement. In light of the amendment to claim 1, it is respectfully submitted that this rejection is moot. Accordingly, the rejection should be withdrawn.

Claim Rejections - 35 USC § 102 and § 103

Claim 1, as amended, recites a storage container for holding a disc-shaped item of recorded media that includes, *inter alia*, a hub extending upwardly from a base. The hub includes a plurality of locking fingers integrally formed with the sidewall of the hub. The locking fingers are spaced from the top surface of the base by a distance greater than the thickness of a standard CD.

Wong et al. fails to disclose or fairly suggest a plurality of locking fingers integrally formed with the sidewall of the hub. Rather, Wong et al. discloses an upward projecting tube (2) and a removable locking knob (4).

O'Brien et al. fails to disclose or fairly suggest locking fingers spaced from the top surface of a base by a distance greater than the thickness of a standard CD. Rather, O'Brien et al. discloses detents (38) that are spaced from a flange (32) by less than the thickness of the recording medium (see, for example, Figure 8 and the associated description). In fact, at column 5, lines 25-29, O'Brien et al. indicates that "the thickness of the recording medium 50 exceeds the gap between the bottom of the detents 38 and the top of the intermediate flange 32 so that the detents 38 cannot overhang the recording medium." (emphasis added).

At paragraph 6, the Office Action acknowledges the deficiencies of O'Brien et al. and relies on Dean to cure these deficiencies. However, it is respectfully submitted that the combination of O'Brien et al. and Dean is improper because modifying O'Brien to include the flexible portion (34) that is disclosed in Dean would render O'Brien et al. unsatisfactory for its intended purpose. See MPEP § 2143.01 and § 2145. In addition

Serial No. 10/693,035

to the portion of O'Brien et al. quoted above, column 2, lines 44-52 of O'Brien et al. discloses the undesirability of retaining fingers extending over the recording medium.

For at least these reasons, it is respectfully submitted that claim 1 and claims 2-7 and 21 dependent therefrom distinguish patentably over the references of record. Accordingly, the rejections should be withdrawn.

Claim 9, as amended, recites a storage container for holding a disc-shaped item of recorded media that includes, *inter alia*, a hub having a continuous cylindrical sidewall and a locking finger projecting outwardly from the sidewall, the locking finger being integrally formed with the sidewall of the hub.

As discussed above, Wong et al. fails to disclose or fairly suggest a plurality of locking fingers integrally formed with the sidewall of the hub. Rather, Wong et al. discloses an upward projecting tube (2) and a removable locking knob (4).

O'Brien et al. fails to disclose a hub having a continuous sidewall. Rather, O'Brien et al. discloses a hub including detents (38) that are defined by U-shaped cutouts (40) in the hub. (See Figure 6 and column 5, lines 1-13). In addition, the hub of O'Brien et al. does not include cylindrical sidewalls. (See Figure 6). At paragraph 6, the Office Action relies on Dean to cure the above-identified deficiencies of O'Brien et al. However, as is discussed above, it is respectfully submitted that O'Brien et al. and Dean are not properly combinable.

For at least these reasons, it is respectfully submitted that claim 9 and claims 10-13 and 22-23 dependent therefrom distinguish patentably over the references of record. Accordingly, the rejections should be withdrawn.

Claim 16, as amended, recites a storage container for holding a disc-shaped item of recorded media that includes, *inter alia*, a hub extending upwardly from a base, the hub including a sidewall and a deflectable locking finger projecting outwardly from the sidewall. The sidewall has a height of 1/16 inch and the locking finger has a height of 1/4 to 1/12 the height of the sidewall.

None of Wong et al., O'Brien et al. and Dean disclose or suggest any sidewall height or locking finger height, let alone, the heights recited in claim 16. The Office Action seems to acknowledge this lack of teaching by any of the references, but asserts

Serial No. 10/693,035

that the recited heights are result-effective variables, the optimization of which involves only routine skill. (citing *In re Boesch*). However, the same paragraph of MPEP § 2144.05 in which *In re Boesch* is cited instructs that "a particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)." None of the above-identified cited references make any mention of hub sidewall height and/or relative locking finger height being a result-effective variable. Further, none of the references disclose any values or ranges of values for the sidewall and/or locking finger heights.

For at least these reasons, it is respectfully submitted that claim 16 and claims 19-20 and 24 dependent therefrom distinguish patentably over the references of record. Accordingly, the rejections should be withdrawn.

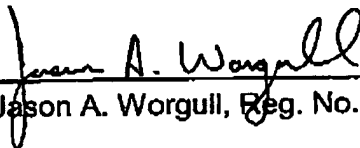
Conclusion

In view of the foregoing, request is made for timely issuance of a notice of allowance.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

By


Jason A. Worgull, Reg. No. 48,044

1621 Euclid Avenue
Nineteenth Floor
Cleveland, Ohio 44115
(216) 621-1113

CERTIFICATE OF FACSIMILE UNDER 37 C.F.R. 1.8

I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office (703-872-9306) on the date shown below.

Date: December 23, 2004


Jason A. Worgull

Z:\SEC152\152\DWB\NEXP\IP0171\IP0171\USB.R01.wpd